

REMARKS

In reply to the Office Action mailed September 12, 2006, Applicants submit the following remarks. Applicants amended claims 112 and 113. Claims 90-113 are presented for examination. Applicants affirm the election with traverse of the invention of Group I, claims 90-113.

The Examiner provided an interview summary (form PTOL-413B) of the interview of August 28, 2006, with the Office Action mailed September 12, 2006. The interview did not result in resolution of all issues. Therefore, the second box of Part III of the Interview Summary should have been checked instead of the first box.

The Examiner rejected claim 90-113 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,681,575 ("Burrell") in view of WO00/44414 ("Fan"). Claims 90-113 cover substrates coated with a water-swellable gel coating including a water-swellable polymer and one or more antimicrobial metals formed with atomic disorder, where the gel coating becomes antimicrobial and anti-inflammatory when wet.

Burrell discloses in passing that antimicrobial metals can be incorporated into a polymeric matrix for use as a material for medical devices coatings. (See, e.g., Burrell, col. 10, lines 37-43.) However, Burrell does not disclose or suggest the coated substrates covered by claims 90-113, nor does Burrell disclose how to make such coated substrates.

Fan discloses a medical device coating that includes a binder polymer, a lubricious polymer, and an antimicrobial material. (See, e.g., Fan, page 8, lines 25-28, and page 10, lines 17-24). The binder polymer has moieties to promote bonding of the lubricious polymer to the medical device substrate. (See, e.g., id., page 8, lines 25-30.) To the extent that Fan discloses medical devices including a lubricious polymer coating and an antimicrobial material, such as silver and its salts, (see, e.g., id., page 6, lines 14-17 and page 6, line 24-page 7, line 4), Fan does not disclose how to make such a coating, and none of Fan's examples disclose a lubricious polymer coating including silver and a water-swellable polymer.

It is well established that a prior art reference does not anticipate a claim if the prior art reference does not enable one skilled in the art to make the subject matter covered by the claim.

(See, e.g., Elan Pharmaceuticals v. Mayo Foundation, 346 F.3d 1051, 1054 (Fed. Cir. 2003).) Also, for the prior art to render the subject matter covered by a claim obvious, the prior art must enable one skilled in the art to make and use the subject matter. (See, e.g., Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989).) Here, without conceding that Burrell or Fan disclose or suggest the coated substrates covered by claims 90-113, none of Burrell or Fan enable the subject matter covered by these claims. In fact, it was surprising to Applicants that the inclusion of the atomically disordered antimicrobial metal component of the coatings adheres well to the substrates and does not interfere with the lubricity properties of the dried coating. (See, e.g., published application, page 1, [0008].) It was also surprising to Applicants that the coatings, which are formed from solutions of the polymer and the metal powder and then dried, continue to provide both antimicrobial and anti-inflammatory activity when rehydrated for actual use, and that the initial hydration of the polymer and the metal powder to form the coating does not deactivate the metal powder. (See, e.g., *id.*).

Further, a person having ordinary skill in the art would not have been motivated to combine the teachings of Fan and Burrell to arrive at the subject matter. And even if a person having ordinary skill in the art were motivated to combine the teachings of Fan and Burrell, the resulting coating still would not have been the coated substrates as required by claims 90-113.

Accordingly, Applicants request reconsideration and withdrawal of the rejection of claims 90-113.

Applicants believe the application is in condition for allowance, which action is requested.

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Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 12/16/06



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